

Attorney Docket No. P71338US0  
Application No. 10/583,088

**Remarks/Arguments:**

Claims \*, newly presented, are pending, with claims \* corresponding to claims withdrawn pursuant to requirement for election of species.

Claims 1-36 are canceled, without prejudice or disclaimer.

In the newly presented claims, the recited oligonucleotides are limited to have a length of 14 to 40 nucleotides. Support for the limitation can be found, e.g., on page 3, lines 10-16 of the application as filed.

The newly presented claims expressly recite an inherent feature of the original claims; i.e., the recited feature "sequences fully complementary"—to SEQ ID NOS: 2-15—is inherent in the limitation—to SEQ ID NOS: 2-15—"and their complementary sequences" recited in the original claims. The inherency is evidenced by the instant specification, at page 5, lines 27-30, which discloses "the invention provides an oligonucleotide that includes sequence SEQ ID NO: 2 or its complementary sequence" (emphasis added), i.e., "its complementary sequence" can only mean the sequence complementary to the full SEQ ID NO: 2—or the sequence there is only one sequence that is complementary to a given sequence, namely the fully complementary sequence."fully complementary thereto," as recited in the present claims. The definition of a claim limitation used to examine the claims must be consistent with that given in the specification. *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). To support a claim amendment the original disclosure need not describe the "invention claimed . . . *in tpsis verbis*." *In re Edwards*, 196 USPQ 465, 468 (CCPA 1978).

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The present claims contain subject matter of the original claims, rewritten to more clearly to define the invention. Additionally, present claims 28, 44, 46, and 50 pertain to a subgroup of oligonucleotides consisting of a sequence selected from the group consisting of SEQ ID NOS: 2-4, 6, and 7 and their complementary sequences. Present claims 29, 38, 42, 45, 51, 52, 58, 59, 65, and 66 are specifically drawn to the elected species, namely, SEQ ID NOS: 2, 3, and 8.

Claims were rejected under 35 USC 112, ¶1, for allegedly lacking supporting written description. Reconsideration is requested.

Applicants submit that the amended claims read on a limited number of oligonucleotides, which are defined both by their size (15 to 40 nucleotides) and by their sequence (comprising any one of SEQ ID Nos. 2-12 or the sequences fully complementary thereto).

Attention is directed to the fact that the subject application provides sufficient guidance—to comply with the written description requirement of §112, ¶1—regarding additional sequences that fall within the claim scope with respect to "oligonucleotides" in addition to the sequences of SEQ ID Nos. 2-15 and sequences fully complementary thereto. Indeed, page 5, lines 14-22, of the subject application (as filed) teaches that the oligonucleotides may comprise, e.g., a spacer sequence, a linker sequence, and a sequence for linking or binding of an enzyme. Such sequences are well-known in the art and commonly used by the skilled person when making and using oligonucleotides. An "application need not teach, and preferably omits, that which is well known in the art." *Staehelin v. Secher*, 24 USPQ2d 1513, 1516 (BPA&I 1992). "[I]t is not necessary to . . . describe in the specification all possible forms in which the claimed principle may be reduced to practice." *Smith*

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*v. Snow*, 294 U.S. 1, 11 (1935). Under §112, first paragraph, the concern of the USPTO is support or non-support for a generic term, not its breadth. *In re Marcozzi*, 169 USPQ 367, 369 (CCPA 1971).

As a matter of fact, the application as filed even provides a working example of such an oligonucleotide, i.e., one comprising sequence SEQ ID NO: 8 and a linker sequence. As indicated on page 7, lines 24 to 34 of the subject application as filed, the oligonucleotide of SEQ ID NO: 12 comprises a sequence of SEQ ID NO: 8 and a 5-bp spacer at each one of the extremities of SEQ ID NO: 8.

In view of the foregoing remarks, the rejection of claims under §112, ¶1, for allegedly lacking supporting written description, is overcome. Withdrawal of the rejection appears to be in order.

Claims 8-11 were rejected under 35 USC 101 for allegedly being non-statutory use claims and under 35 USC 112, 2<sup>nd</sup> ¶, for allegedly being indefinite. Reconsideration of the rejections is requested in view of amendments to the rejected claims—reflected in present (new) claims 36-41.

The rejected claims are rewritten—in the present claims—as "method" claims, including affirmatively recited method steps. Accordingly, the §101 and §112, ¶2, rejections are overcome and withdrawal of the rejections appears to be in order.

Claims were rejected under 35 USC 102(b) for allegedly being anticipated by Saito as allegedly evidenced by Heid. Claims were rejected under 35 USC 102(a) and 102(e) for allegedly being anticipated by Pasupuletti. Reconsideration of the §102 rejections is requested, in view of the changes to the claims effected, hereby.

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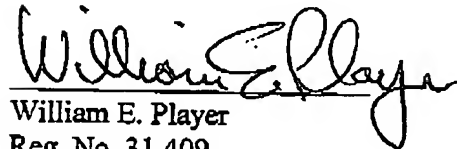
Applicants submit that each of the anticipation rejections is rendered moot in view of the amendments to the rejected claims—reflected in the present claims. Indeed, the present claims are expressly limited to oligonucleotides of specified SEQ ID NOS:—found in the Sequence Listing—and those sequences "fully complementary thereto" (emphasis added); which oligonucleotides of specified SEQ ID NOS: and those "sequences fully complementary thereto" are admitted, apparently, as being absent from both Saito and Pasupuletti, relied on to reject the claims; i.e., the present claims do not read on oligonucleotides comprising di- or tri-nucleotides—disclosed in the cited references—that are complementary to a fragment of SEQ ID NOS. 2-8, which di- or tri-nucleotides were apparently relied on to fully meet the rejected claims. The "absence" from a prior art reference of a single claim limitation "negates anticipation." *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986).

In view of the foregoing remarks, the rejections of claims under §102(b), §102(a), and §102(e), for alleged lack of novelty, are overcome. Withdrawal of the rejections appears to be in order.

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Favorable action is requested.

Respectfully submitted,



William E. Player  
Reg. No. 31,409  
Attorney of Record

JACOBSON HOLMAN PLLC  
400 Seventh Street, NW  
The Jenifer Building  
Washington, D.C. 20004  
Tel (202) 638-6666  
Fax (202) 393-5350  
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